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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,368	02/28/2002	Andreas Meudt	2001DE305	6588

25255 7590 09/26/2003

CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
4000 MONROE ROAD  
CHARLOTTE, NC 28205

EXAMINER

PATEL, SUDHAKER B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/26/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/085,368

Applicant(s)

MEUDT ET AL.

Examiner

Sudhaker B. Patel, D.Sc.Tech.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 8.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Applicants' communication paper # 7 dated 9/2/03 is acknowledged.

Based on applicants remarks, arguments, and telephonic interview dated 9/25/03, the restriction/election has been modified in the following way. See interview summary.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims (in part) 1-4,6-8,10, drawn **to first recited process** of making Formula (I) compounds related to boronic acid without Phosphorous, Silicone, classified in class 568, subclass 1, 886.
- II. Claims (in part) 1-10, drawn to processes and compounds not elected in above stated Group I, i.e. Compounds involving P and Si, Formulae (I)/(II), Borinic acids of the same, and compounds wherein X, Y, Z are other than carbons, forming 5- and 6- membered heterocycle and non heterocycle structures etc., classified in class 568, 546, 544,549, subclasses various depending on the nature of variables. If this group is elected further restriction/election will be required as there are many unknowns. .

The inventions are distinct, each from the other because of the following reasons.

The compounds of Groups I-II are drawn to: **Different processes**, and additionally, processes are making:

- (1). Structurally diverse compounds that are made and used independently of each other;

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- (2). Compounds are separately classified;
- (3). Classes will require separate literature searches;
- (4). Compounds are not art recognized equivalents,
- (5). The groups lack unity of invention (see MPEP 803.02).

Based on above stated data i.e. (1) - (5)., claim 1 also lacks unity of invention.

1. Inventions II and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are: (1). Different chemical structures. (2). Having different basicity or acidity. (3). Having different mole ratios for organic molecule to Boron atom.
2. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention: 1). When Z, Y, Z all are carbons i.e. benzene core. 2). When one of X, Y, Z is N and the rest are carbons i.e. 6-membered pyridine core. 3). When two of X, Y, Z are N and the rest is carbon i.e. 6-membered pyrimidine or pyridazine core. 4). When X, Y, Z form a 5-membered Furan ring. 5). When X, Y, Z form

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5-membered thien core. 6). When X, Y, Z form 5-membered pyrrole core. 7). When X, Y, Z, R4', R5' are other than C i.e. Phosphorous or Silicone consisting cores.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,4,5,7,9,10 are generic.

Applicant is advised that a reply to this requirement must include an identification of the single species from working examples that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call (see interview summary) was made to Mr. S. Hanf on 9/25/03 to request an oral election to the above restriction requirement, but did not result in an election being made because applicants would like to discuss the matter with their overseas clients prior replying to office action.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709. The examiner can normally be reached on 6:30 to 5:00 pm.Monday-Thursday.

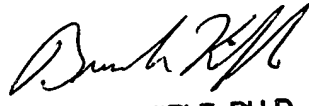
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at 703 308 4523.


The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.

  
Sudhaker B. Patel, D.Sc. Tech.  
August 25, 2003.

  
BRUCE KIFLE, PH.D.  
PRIMARY EXAMINER

  
MUKUND SHAH  
SUPERVISORY PATENT  
EXAMINER  
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